

REMARKS

The Applicant thanks the Examiner for the thorough examination of the application. No new matter is believed to be added to the application by this Amendment.

Entry of Amendment

Entry of this Amendment under 37 C.F.R. §1.116 is respectfully requested because it places the application in condition for allowance. Alternately, entry is requested because it places the application in better form for appeal.

Status of the Claims

Claim 1 is pending in the application. Claim 1 has been amended to correct minor errors. The amendments to claim 1 raise no new issues and do not alter the claim's scope.

Rejection Under 35 U.S.C. §103(a) Over Yoshimasa et al.

Claim 1 has been rejected by the Examiner under 35 USC 103(a) as being obvious over Yoshimasa et al., JP 06-327791. This rejection is respectfully traversed.

The Present Invention and its Advantages

The present invention is directed to a floatable golf ball for use in a driving range, which possesses excellent durability, and good shot feel.

In golf balls utilized in driving ranges, it is required for such golf balls to possess substantially the same qualities in performance as golf balls which are utilized for playing a normal round of golf. Also, it is advantageous if the golf balls used in driving ranges are floatable since many driving ranges face water-hazards in order to recreate water hazards which might be normally experienced in a round of golf.

The present invention finds a typical embodiment in claim 1:

1. A floatable golf ball for a driving range comprising a core and a cover covering the core, wherein
 - the cover has a flexural modulus (F) of 80 to 300 Mpa,
 - the golf ball has a specific gravity of not less than 0.5 and less than 1.0, and a deformation amount (D) of 3.0 to 6.0 mm when applying from an initial load of 98 N to a final load of 1275 N, and
 - a ratio (F/D) of the flexural modulus of the cover (F) to the deformation amount of the golf ball (D) is with the range of 24 to 31.

Distinctions of the Invention Over Yoshimasa et al.

Distinctions of the invention over Yoshimasa et al. are of record in the application.

Yoshimasa et al. pertains to a two-piece floatable golf ball that has a low specific gravity and floats on water. Yoshimasa et al. is discussed in paragraph 0004 at page 2 of the specification. However, Yoshimasa et al. typifies the

conventional art and its associated disadvantages. These disadvantages of hardness and poor shot feel are discussed in paragraph 0005 at pages 2-3 of the specification:

However, the golf ball for round games has possessed very soft and good shot feel and high rebound characteristics by the recent remarkable improvement of performance of the golf ball. Therefore the two-piece floatable golf ball for water-facing driving ranges was evaluated to have good shot feel when it was proposed, but such a conventional golf ball for driving ranges does not agree with requirement for the existing golf ball. It is problem that the conventional golf ball for driving ranges is very hard and has poor shot feel, because the core is hard and stiffness of the cover is too high.

That is, the present inventor has recognized the golf ball of Yoshimasa et al. as being a golf ball having the above-described problems at the time of filing of the present application. In contrast, the golf ball of the present invention has excellent durability while maintaining soft and good shot feel by adjusting the F/D value to the range of 24 to 31, even if the flexural modulus (F) of the cover is low.

In the Reply filed March 19, 2004, Figures A and B were presented to highlight the fundamental differences between the invention and the conventional art typified by Yoshimasa et al. Figures A and B are reproduced below.

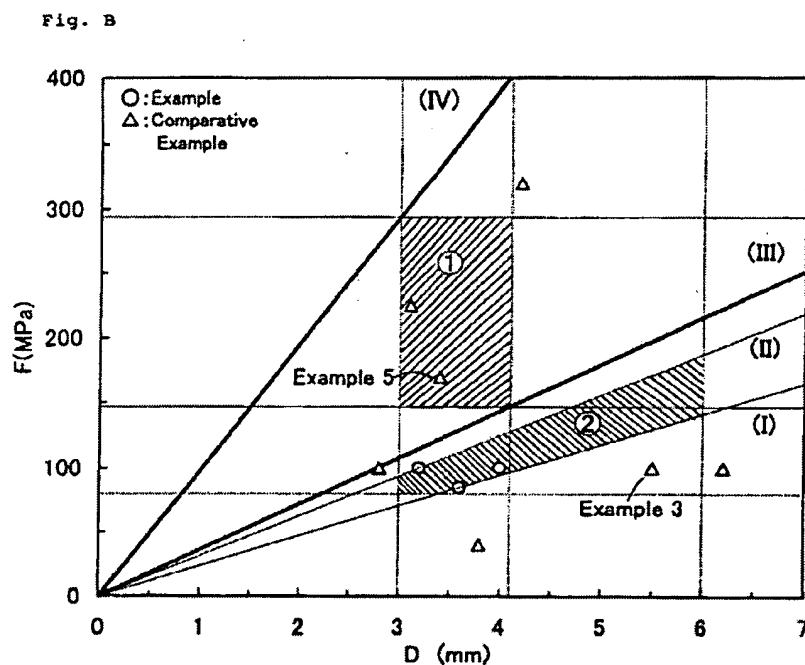
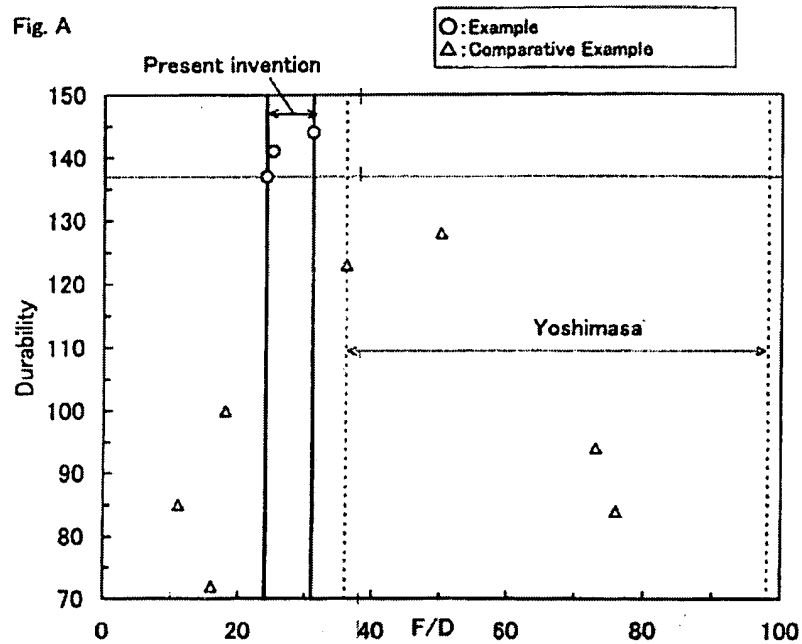


Figure A shows a graph displaying the relationship between the F/D value (x-axis) and the durability (y-axis) shown in Tables 5 and 6 at pages 24 and 25 of the specification. However, Example 3 having an F/D value of 18

and Example 5 having an F/D value of 50 are shown as Comparative Examples. The F/D values of the present invention are within the range of 24 to 31, and the F/D values of Yoshimasa et al. are within the range of 36 to 98. As shown in Figure A, the golf ball having the F/D value range of 24 to 31 has a durability of not less than 137, but the golf ball having the F/D value range of 24 to 31 has a durability of not more than 128.

Therefore, the durability of the inventive golf ball is excellent when the F/D value is within the range of 24 to 31. Since the golf ball of Yoshimasa et al. has an F/D value out of the range of 24 to 31, the durability is much poorer than that of the present invention.

Further, Figure A in particular shows excellent results for durability that lie to the left of the F/D peak of the Comparative Examples' Gaussian curve. That is, a person having ordinary skill using the teachings of Yoshimasa et al. would see the durability decrease as the F/D decreases from 50, and as a result, would have no motivation to further reduce the F/D value to attain the elevated durability results of the invention. Thus, the invention represents a true unexpected result over Yoshimasa et al.

Figure B further elucidates the fundamental differences between the invention and Yoshimasa et al. The F/D value of Yoshimasa et al. (area ① shown in Figure B) is different from the F/D value of the present invention (area ② shown in Figure B), ***even if both golf balls have the same value of F or D***. Therefore, the golf ball of Yoshimasa et al. having an F/D range of the

present invention's range is quite different from the golf ball of the present invention.

Further, at page 2 of the Office Action, the Examiner asserts that since the specification discloses an overall range of F/D=15 to 50 (specification at page 4, lines 6-8), that it would be "an obvious modification" to utilize the claimed F/D ratio of 24 to 31. However, the Examiner chooses to ignore the discussion in paragraph 0013 at pages 6 and 7 of the specification that points out the advantages of the preferred ranges. As a result, the specification does teach away from Yoshimasa in contrast to the Examiner's assertion at page 3, lines 10-12 of the Office Action. It is improper to combine references where the references teach away from their combination. In re Grasselli, 713 F.2d 731, 218 USPQ 769, 779 (Fed. Cir. 1983).

Also, the Examiner is utilizing an improper "obvious to try" rationale.

The admonition that 'obvious to try' is not the standard under 103 has been directed mainly at two kinds of error. In some cases, what would have been 'obvious to try' would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful In others, what was 'obvious to try' was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it. In re O'Farrell, 853 F.2d 894, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) (citations omitted) (The court held the claimed method would have been obvious over the prior art relied upon because one reference contained a detailed enabling methodology, a suggestion to modify the prior art to produce the claimed invention, and evidence suggesting the modification would be successful.). See also In re Eli Lilly & Co., 902 F.2d 943, 14

USPQ2d 1741 (Fed. Cir. 1990) and In re Ball Corp., 18 USPQ2d 1491 (Fed. Cir. 1991).

In this case, the Examiner has failed to point out where Yoshimasa et al. contained a detailed enabling methodology, or a suggestion to modify the prior art to produce the claimed invention.

Yet further, the Examiner is basing his rejection upon a single reference. To establish a *prima facie* case of obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP §2143. In addition, if a reference needs to be modified to achieve the claimed invention "there must be a showing of a suggestion or motivation to modify the teachings of that reference to the claimed invention in order to support the obviousness conclusion." Sibia Neurosciences Inc. v. Cadus Pharmaceutical Corp. 55 USPQ2d 1927 (Fed. Cir. 2000). However, the Examiner turns to the applicant's own disclosure and fails to point out how the F/D range of the invention (and its unexpected results) can be derived from Yoshimasa et al.

Therefore, the Examiner has failed to successfully allege a case of *prima facie* obviousness over claim 1. Even if obviousness could be alleged, this obviousness would be fully rebutted by the unexpected results discussed above.

This rejection is accordingly overcome and withdrawal thereof is respectfully requested.

Information Disclosure Statement

The Examiner is thanked for considering the Information Disclosure Statement filed May 15, 2001, and for making the initialed PTO-1449 form of record in the application in the Office Action mailed May 21, 2002.

Prior Art

The prior Art cited but not utilized by the Examiner indicates the status of the convention art that the invention supercedes. Additional remarks are accordingly not necessary.

The Drawing

The Examiner is respectfully requested to indicate whether the drawing figure is acceptable in the next official action.

Foreign Priority

The Examiner has acknowledged foreign priority.

Conclusion

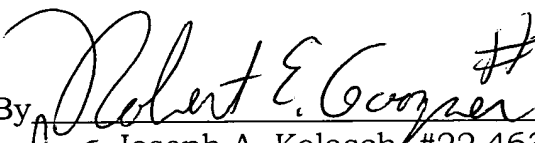
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert E. Goozner, Ph.D. (Reg. No. 42,593) at the telephone number of the undersigned

below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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